

### III. Remarks/Arguments

This Amendment is in response to the final Office Action mailed November 27, 2006. In the Office Action, a shortened statutory period of three (3) months was specified so that the due date for the response is on or before February 27, 2007.

A short review of the prosecution history and status of the claims is appropriate. The application was filed with claims 1- 26. The Examiner requested an election between "patentably distinct species of the claimed invention", and the Applicant made a provisional election directed to Figures 1-8 and existing claims 1-13. Claims 14-26 were withdrawn to be filed subsequently in a Divisional Application.

A first Office Action mailed on Sept. 1, 2005, rejected claims 1-9 under 35 U.S.C. 102(b) as being anticipated by Rall (US Patent No. 5,611,256), and rejected claims 10-13 under 35 U.S.C. 103(a) as being unpatentable over Rall in view Yerkes (US Patent No. 2,524,582).

In response, the preamble of Claim 1 was amended to include dual non-circular holes *adapted to receive a two-prong fastener*. New claims 27-30 were added to further claim the invention. Independent claim 27 specified *exactly two punches*, independent claim 28 specified that the punches are *in line*, independent claim 29 was a method claim directed to use of the dual-hole punch, while dependant claim 30 further defined the method. Portions of the specification and drawing informalities were also corrected.

A second Office Action mailed on February 16, 2006, where Claims 29 and 30 were withdrawn by the Examiner as being independent or distinct from the invention originally claimed. Claim 28 was objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1, and Claim 27 was rejected under 35 U.S.C. 112, first paragraph for failing to

comply with the written description. Claims 1-9 were rejected under 35 U.S.C. 102(b) as being anticipated by Rall. Claims 10-13 were rejected under 103(a) as being unpatentable over Rall in view of Yerkes (U.S. Patent No. 2,524,582).

In response, Applicant noted the withdrawn status of claims 29 and 30 in the claim listing, cancelled Claim 28, and cancelled Claim 27. The Claim 27 limitation of "exactly two punches" was modified to read "only two punches", and added to Claim 1. Claim 6 was modified to include the limitation of dual punches having centers "positioned two and three quarters inches" apart. Applicant also filed a Request for Continued Examination with the Response to the second Office Action in order to facilitate an additional prior art search directed to two-hole punch devices.

In third Office Action mailed on July 6, 2006 rejected claims 1-5 and 7-9 under 35 U.S.C. 103(a) as being unpatentable over Glaeser (US Patent No. 1,738,572) in view of Davies (US Patent No. 6,439,093). Claim 6 was rejected under U.S.C. 103(a) as being unpatentable over Glaeser in view of Davies and Applicant's aapa, when the Examiner noted that aapa teaches that punches having punch centers spaced 2.75 inches apart are old and well-known. Claims 10-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Glaeser in view of Davies and further in view of Yerkes (US Patent No. 2,524,582).

The Applicant modified Claim 1 to included that the two punches are operable to perforate the at least one sheet of paper to create associated non-circular holes having uninterrupted perimeters in response to movement of the lever arm towards the base plate.

US Patent No. 6,439,093 to Davies describes a sheet punch device for use with an oversized sheet of paper where the sheet punch device is configured to "provide one or

more punch outs for a standard sized ring binder and [to provide] at least one cutout opening therein that allows the oversized paper to be secure in a standard ring binder when the oversized paper is folded at 90 degrees....” The Applicant respectfully notes that the sheet punch of Davies is designed to enable an oversized paper to be received in a *standard sized ring binder*, not to be received by a two prong fastener as the Applicant described and claimed in the instant invention.

The Applicant also respectfully notes that the cutout punch heads shown in FIGS. 5b (forms an oval cutout), 5f (forms a rectangular cut out), 5h (forms a curvilinear cutout) and 5j (forms a corner cutout) of Davies, are just that; cutout punch heads for purposes of producing an oval, rectangular, curvilinear, or corner *cutout opening* configured to enable the oversized portion of the paper to be “folded, unfolded and refolded to reveal the entire length of the oversized sheet while the sheet remains bound by the three standard rings without the necessity of opening any of the rings” (Davies col. 5, lines 20-25). The “cutout extends to the edge over the oversized paper and aligns with...” (Davies col. 5, lines 48-50). Thus, unlike the Applicant’s invention, the cutout punches of Davies are not configured to form *dual non-circular holes* or more precisely, any *non-circular holes having uninterrupted perimeters*.

The Applicant further defined Claim 1 to include “the second portion of the guide bracket including a first curvilinear portion sized to incorporate a first bore extending therethrough and including a second curvilinear portion sized to incorporate a second bore extending therethrough” as shown in FIGS. 1 and 2. Claim 5 was modified to correct a typo. Claim 6 was modified to remove the words “wherein a center of the bottom end non-circular cutting surface of the first punch is positioned two and three quarters inches from a

center of the bottom end non-circular cutting surface of the second punch”, thereby reinstating Claim 6 to it’s original wording.

A fourth Office Action mailed on November 27, 2006 rejected claims 1-5 and 7-9 under 35 U.S.C. 103(a) as being unpatentable over Glaeser (US Patent No. 1,738,572) in view of Davies (US Patent No. 6,439,093). Claim 6 was rejected under U.S.C. 103(a) as being unpatentable over Glaeser in view of Davies and Applicant’s aapa, when the Examiner noted that aapa teaches that punches having punch centers spaced 2.75 inches apart are old and well-known. Claims 10-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Glaeser in view of Davies and further in view of Yerkes (US Patent No. 2,524,582). The Examiner further noted that Glaeser incorporates two curvilinear portions.

Applicant amended Claim 1 to include the adjustable paper guide assembly previously claimed in dependant Claim 11. Neither Glaeser nor Davies alone or in combination suggests a dual hole punch for perforating at least one sheet of paper with dual non-circular holes adapted to receive a two-prong fastener, that further includes an adjustable paper guide assembly. Further, Davies clearly requires the use of at least one cutout to accommodate an oversized sheet of paper as discussed above; there is no suggestion or motivation for a *dual* hole punch with dual non-circular holes.

In response to Examiners assertion that Claim 11 is unpatentable over Glaeser in view of Davies and further in view of Yerkes, Applicant notes that Yerkes does not suggest a dual hole punch for perforating at least one sheet of paper with dual non-circular holes adapted to receive a two-prong fastener, that further includes an adjustable paper guide assembly. The *teaching or suggestion to make the claimed combination* and the

reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

Finally, the Applicant would like to point out that the pending patent of the instant invention was initiated by the Applicant due to an inability to find any device that addressed a problem; namely the problem of dual prong fasteners tearing circular punched holes in a sheet(s) of paper. Although not a particularly dreadful problem, the problem was nevertheless "well-known" by those working with dual-hole punched paper these past 80 years. Applicant believes that, because such a long-felt need has not previously been addressed *with a reasonable expectation of success*, that the instant invention is not rendered obvious by the teachings of Davies, Glaeser and Yerkes.

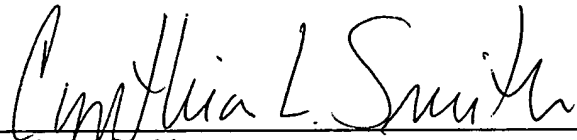
#### **IV. Conclusion**

For the reasons stated above, the Applicant respectfully submits that Claim 1 and its dependant Claims 2-9 are not unpatentable over Glaeser in view of Davies, nor are Claims 10 and 12-13 unpatentable over Glaeser in view of Davies and further in view of Yerkes. Accordingly, further and favorable reconsideration by the Examiner is therefore urged.

With the foregoing in mind, applicant respectfully requests that the Examiner place the present application in condition for allowance.

Should the Examiner be of the opinion that further amendments or response is required the Applicant encourages the Examiner to contact the undersigned attorney at the telephone number set forth below.

Regards,

A handwritten signature in cursive script, reading "Cynthia L. Smith", written over a horizontal line.

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